

Amendment for Application No.: 10/712869
Attorney Docket: CFA00018US

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REMARKS

Summary of the Office Action

In the Office Action dated January 23, 2008, claims 1, 2, 5-9, 12, 14, 15, 18-22, and 24-27 were pending, all of which were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. patent No. 7,162,635 B2 to Bisbee et al. (herein BISBEE) variously in view of U.S. patent No. 6,918,083 B2 to Smith (herein SMITH), U.S. patent No. 5,982,891 to Ginter et al. (herein GINTER), and U.S. patent No. 5,473,691 to Menezes et al. (herein MENEZES).

Summary of the Amendment

Claims 1, 2, 5-9, 12, 14, 15, 18-22, and 24-27 are currently pending, of which claims 1, 12, 18, and 20 are currently amended. The rejections of claims 1, 2, 5-9, 12, 14, 15, 18-22, and 24-27 under 35 U.S.C. § 103(a) are respectfully traversed.

Patentability over Cited Art

Claims 1, 2, 5-9, 12, 14, 15, 18-22, and 24-27 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable as discussed above. Applicant respectfully traverses.

Applicant respectfully submits that BISBEE is seen at best to disclose appending to a digital document: the digital signature and certificate of the document submitter, a time stamp when a Trusted Custodial Utility (TCU) assumes control of the document, and a digital signature and certificate of the TCU.

The independent claims 1, 12, 18, and 20 include numerous features not discussed or disclosed in BISBEE. For instance, BISBEE fails to discuss or disclose, *inter alia*, ... "modification information that indicates how to modify the original data to obtain modified original data". The Office Action concedes this point, for example, in item 4 on page 3.

However, the Office Action asserts that the quoted feature can be found in column 3, lines 21-30, of SMITH. These lines of SMITH indicate that: "The editor 44 transfers, via communication channel 30, markup, surface, and color-coded markup overlays, to the display 28. The editor 44 receives, via communication channel 18, user

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entered markup via keyboard 16, and also receives, via communication channel 22, user commands from the mouse 20. The editor 44 also transfers, via communication channel 34, markup document with overlays or markup summary and reports to the printer 32. Still further, the editor 44 transfers, via signal path 56, updated mku file and attachments to the compressor 50."

Applicant respectfully submits that SMITH fails to discuss or disclose the above-identified feature of claims 1, 12, 18, and 20. In particular, column 3, lines 21-30, of SMITH appears at best merely to discuss an editor that receives markup via user input provided via a keyboard and provides a marked up document (identified as mark up data) in a format (having file extension ".mkd") distinct from that an original. Applicant sees no indication that the mark up data indicates how to modify the original. Rather, it appears merely to be a modified version of the original stored in a format distinct from that of the original. This markup data does not appear to indicate how to modify the original. Rather, it appears merely to include changes to an original. It appears that the user may determine whether or how to modify the original using the mark up data as input. For example, lines 1-7 of column 4 of SMITH indicate that: "In the operation of the re-converter 46, the user manually transfers, using the mark-up tool and the native document editor, markups from the markup tool 12 to the native document" (emphasis added). However, leaving it up to the user to decide how to make changes fails to teach "modification information that indicates how to modify the original data to obtain modified original data" in the manner variously claimed.

The independent claims 1, 12, 18, and 20 also variously recite, *inter alia*, ... "creating, by using secret information, modification-assuring-information for detecting whether the modification information has been altered" (claims 1 and 18) and "verifying, by the modification-assuring-information and secret information, that modification information regarding a modification of the original data is assured as not having been altered" (claims 12 and 20). These features are not discussed or disclosed in the cited references.

The Office Action finds that lines 46-50 of column 13 of BISBEE disclose "modification-assuring-information". Applicant respectfully disagrees. The cited lines of BISBEE at best discuss a digital signature and certificate which is appended to an

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e-original. The digital signature of BISBEE is not applied to any modification information. Indeed, the Office Action itself appears to concede this point by finding that BISBEE lacks disclosure any such modification information (Office Action, item 4, page 3). Rather, in BISBEE the digital signature and certificate is applied to the modified document, a result of a modification, not to any modification information that indicates how to modify original data to obtain modified original data. Furthermore, SMITH is silent regarding modification-assuring-information. Thus, both BISBEE and SMITH fail to suggest "modification-assuring-information" in the manner variously claimed.

Moreover, BISBEE and SMITH fail to suggest having both "modification-assuring-information" and "original-data assuring information". In BISBEE, for example, a digital signature is applied to an entire document (an e-original), not to distinct portions of that document. SMITH adds nothing to BISBEE in this regard as SMITH does not address assuring information of any kind. The Office Action appears to concede this point, as it still relies on BISBEE with respect to assuring information, not SMITH.

Moreover, Applicant respectfully submits that BISBEE and SMITH are not properly combinable as suggested by the Office Action. For example, in BISBEE "[a]n e-original in an account is replaced when an authorized party checks out and retrieves the e-original and submits an updated version" (emphasis added). BISBEE relies on this functionality. In particular, an updated version is a new e-original which replaces the prior e-original. Even if one were to assume merely for the sake of argument that the markup of SMITH teaches how to modify an original (which Applicant respectfully does not concede) as asserted in the Office Action, such markup would appear to conflict with the replacement based strategy of BISBEE. Moreover, the Office Action suggests that the one skilled in the art would be motivated to include such markup to notify an associated authority of changes about to be made to a document before the changes are actually accomplished, citing column 1, lines 58-61 of SMITH. However, in BISBEE, the updated version of the e-original already includes the revisions, so it appears in the structure of BISBEE to be too late to provide any notice of changes about to be made before the changes are actually accomplished. Thus, the asserted motivation conflicts with the required structure of BISBEE.

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The other cited references, GINTER and MENEZES, are not seen as adversely impacting the patentability of these claims. Moreover, Applicant notes that they were asserted in the Office Action only against some of the dependent claims, and thus the Office Action appears to recognize that they are not relevant to the patentability of claims 1, 12, 18, and 20, for example. Applicant therefore respectfully submits that independent claims 1, 12, 18, and 20 are patentable over BISBEE, SMITH, GINTER, and MENEZES, whether considered alone or in combination.

Since each dependent claim incorporates all the features of its respective base claim by dependency, and adds further distinguishing features thereto, each of the dependent claims is likewise submitted to be patentable over BISBEE, SMITH, GINTER, and MENEZES, whether considered alone or in combination, for at least the reasons provided above with respect to its respective base claim. Reconsideration and allowance of the pending claims is respectfully solicited.

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Applicant respectfully submits that all of the claims pending in the application meet the requirements for patentability and respectfully requests that the Examiner indicate the allowance of such claims at her earliest convenience.

Any amendments to the claims which have been made in this response which have not been specifically noted to overcome a rejection based upon prior art should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

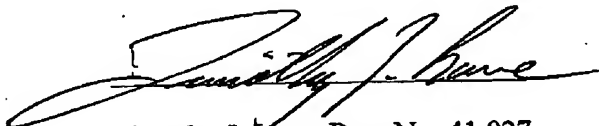
Please charge all required fees, including the fee for extension of time by two-months, to Deposit Account Number 502456.

Should the Examiner have any questions, the Examiner may contact Applicant's representative at the telephone number provided below.

Respectfully submitted,

June 23, 2008

Date



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